

REMARKS

Upon entry of the present amendment, claims 1 and 4 will remain pending in the above-identified application, with claim 1 standing allowed and claim 4 standing ready for rejoinder in accordance with the provisions of MPEP § 821.04. Claims 2-3 and 5-7 have been cancelled as being directed to a non-elected invention. Applicants reserve their rights to file divisional application(s) on the cancelled subject matter.

The specification has also been amended to recite a proper cross-referencing paragraph claiming priority under 35 USC § 120 to parent application serial no. 10/097,009 (of which the present application is a divisional), and under 35 USC § 119 to JP 2001-071784 filed on March 14, 2001.

Initial Comments

In the outstanding office action at page 2, line 2, of the office action, it is stated that claims 1-14 are previously pending in the application, this is incorrect, as claims 1-7 were previously pending in the application.

In the outstanding office action at page 6, lines 5-9, the Examiner indicates as follows.

Claim 1 is allowable over the closet (sic.) prior art, Hassila et al. US Patent No. US 6,762,306. Claim 1 of this application is to a chiral phosphine compound

where in AR is a heteroaryl group. The closest prior art of record teaches AR as an aryl group. Therefore the compound claimed by the applicant is allowable over the prior art.

The above statement of the Examiner is a little confusing since it does not recognize that the present application is a divisional application of Application Serial No. 10/097,009 (from which US 6,762,306 issued), or that US 6,762,306 discloses, but does not claim, the compounds of formula (1) recited in instant claims 1 and 4.

Further, the present application is directed to subject matter already deemed patentably distinct from the invention prosecuted and ultimately allowed in the parent application serial no. 10/097,009 (now US 6,762,306). In support of this contention, one need only look to the Examiner's January 15, 2003 Non-Final office action in parent application serial no. 10/097,009 and more particularly comments set forth therein at page 5, line 17 to page 6, line 10.

The Examiner is respectfully requested to clarify the above point when issuing the notice of allowance in the matter of the present case.

Restriction Requirement

The Examiner previously issued a verbal restriction requirement in the matter of the instant application, contending that 5 patentably distinct invention were encompassed by original claims 1-7, with the 5 distinct inventions being as follows:

Invention I - Claim 1

Invention IV - Claim 5

Invention II - Claims 2-3

Invention V - Claims 6-7

Invention III - Claim 4

In response to the restriction requirement, applicant's elected Invention 1 - claim 1, with traverse. Traversal is based on the fact that no undue burden would be placed on the Examiner to consider each of pending claims 1-7 at present.

Even though Applicant's have elected to prosecute claim 1 in the instant application, rejoinder of claim 4 is requested based on the fact that the Examiner has indicated that claim 1 is allowed, and rejoinder of claim 4 is fully appropriate under the provisions of MPEP § 821.04.

CONCLUSION

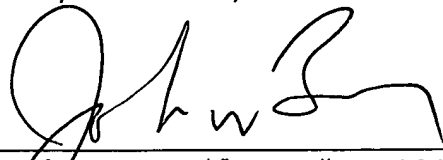
Applicants appreciate the Examiner's courtesy in indicating that claim 1 is allowed, and submit that based on the allowability of claim 1, rejoinder of claim 4 is required at present.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact John W. Bailey (Reg. No. 32,881) at the telephone number below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

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